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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,039	02/09/2005	Stephan Bauer	264733US0PCT	4851
22850 7590 04/01/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER COONEY, JOHN M				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 04/01/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/524,039

**Applicant(s)**

BAUER ET AL.

**Examiner**

John Cooney

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-20 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-20 and 22-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-20-08 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-20, and 22-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claims are confusing as to intent because it can not be determined upon which basis and/or standard the claimed FOG and VOC values are intended to be based. The basis of determination of FOG and VOC values are not so readily understood in the art that the claims do not need to recite the basis of their determination. Though applicants' submitted test standard information is noted. This test standard basis information would need to be inserted into the claims to give these values in the claims definiteness and relevance as claim limitations, and support for

such test standard basis information would necessarily need to be shown to be evident in applicants' originally filed supporting disclosure.

Claims 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claim 31 is confusing as to intent because it can not be determined upon which basis and/or standard the claimed odor values are intended to be based. The basis of determination of odor values is not so readily understood in the art that the claim does not need to recite the basis of its determination. This test standard basis information would need to be inserted into the claims to give these values in the claims definiteness and relevance as claim limitations, and support for such test standard basis information would necessarily need to be shown to be evident in applicants' originally filed supporting disclosure.

Claims 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claim 27 is confusing as to intent because it can not be determined upon which basis and/or standard the claimed compression set values are intended to be based. The basis of determination of compression set values is not so readily understood in the art that the claim does not need to recite the basis of its

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determination. This test standard basis information would need to be inserted into the claims to give these values in the claims definiteness and relevance as claim limitations, and support for such test standard basis information would necessarily need to be shown to be evident in applicants' originally filed supporting disclosure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20, and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al.(6,313,060) in view of JP-05163342.

Sugiyama et al. discloses preparations of flexible polyurethane foams by mixing and reacting polyols of low-unsaturation and having molecular weights as claimed and prepared using the double metal cyanide catalysts (DMC), and isocyanates under foam forming conditions to form resilient foamed articles (see the entire document).

Sugiyama et al.'s teachings differ from applicants' claims in that it does not particularly require renewable materials as initiators in the making of its DMC catalyzed polyols. However, Sugiyama et al. (see column 8 lines 26-42) is not limited to the specific initiator exemplified, and JP-05163342 discloses DMC catalyzed polyols made

from initiators as defined by applicants' claims to be useful in polyurethane preparations (see the abstract, as well as, entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the renewable material initiators for DMC catalyzed polyols disclosed by JP-05163342 in the preparations of Sugiyama et al. for the purpose of providing environmentally desirable and operationally acceptable reactive materials in products prepared in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Difference is not seen in the ranges of cyclic fatty acid ester content values of applicants' claims as content of these materials are not evident in the teachings of the prior art. Foams having excellent vibration, compression, and other physical properties would be expected from the combined teachings of the prior art. Accordingly, difference based on the ranges of compression values of applicants' claims is not seen. The recite "low" and "reduced" values referred to by the claims are relative and do not distinguish over the combined teachings of the prior art.

Applicants' arguments have been considered. However, rejections are maintained. Examiner maintains rejection to be properly applied as set forth in the rejection above. Motivation to combine is maintained as proper. The JP-'342 patents disclosure of the use of these polyols in polyurethanes is sufficient to support this reference's applicability as art properly combinable with the primary Sugiyama et al. teaching. Additionally, a factually supported showing of new or unexpected results

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attributable to the differences in applicants' claims that is commensurate in scope with the scope of applicants' claims has not been made in order to overcome the instant rejection. Assertions of acceptable behaviors and low-emissions do not substitute for a factually supported showing of new or unexpected results attributable to the differences in applicants' claims. Further, differences in the articles formed as claimed in the newly submitted claims are not seen to be evident.

Applicants' amendments and arguments are noted. However, the recited FOG and VOC values lack relevance in distinguishing the claims in the patentable sense.

Additionally, even if relevance of these values were established through proper incorporation of the basis of these values determinations into the claims, it is seen that such behaviors are intrinsically associated with the combinations of materials arrived at through the combinations of the teachings of the cited prior art set forth above.

Applicants' have not established evidence that the compositions differ in their material make-up based on the recited ranges of property determination values set forth in the claims so that the rejection as set forth above fails. As far as overcoming the grounds of rejection, it is held and maintained that the recitation of these ranges of values in the claims, even with properly established basis, are not seen to substitute for a clear and convincing, factually supported, showing of new or unexpected results that are commensurate in scope with the scope of the claims.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Rejection of applicants' claims based on the combination of teachings, as set forth, is maintained to be proper, and this rejection has not been refuted or overcome. Sugiyama et al. discloses systems using the DMC catalysts of the instant concern and JP-'342 addresses its deficiency in showing the use of a renewable initiator, as defined by applicants' claims, with DMC catalysts in the making of polyether polyols. Rejection has not been shown to fail, nor has it been shown to be overcome by a sufficient showing of new or unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796



**Application Number****Application/Control No.**

10/524,039

**Applicant(s)/Patent under  
Reexamination**

BAUER ET AL.

**Examiner**

John Cooney

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